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09/591,539	06/09/2000	Tina Marie Nielsen		3228

7590 11/21/2003  
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EXAMINER

ARNOLD III, TROY G

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 11/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/591,539

Applicant(s)

NIELSEN ET AL.

Examiner

Troy Arnold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-48 is/are pending in the application.
- 4a) Of the above claim(s) 29-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Upon further consideration of the newly submitted claims, the oral restriction requirement made 4 November 2003 in the form of a phone call to the Applicant's Attorney, is withdrawn and the following action is taken:

Newly submitted claims 29-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 29-38 claim a method of making and using a sheet/case, and claims 39-48 claim a method of making a sheet/case. The article claimed, the sheet/case, could be made in a manner materially different from that claimed in claims 29 and 39. For example, it could be made by attaching two sheets, one large, one small, together, and then sewing up the case. Or it could be made by folding up a big sheet, and then sewing a little one around it to form the case.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wade in view of Hunt. Wade teaches all the limitations of claim 15 except a) the case being attached inwardly of the first end of the sheet and b) the open first end of the carrying case facing a longitudinal edge of the sheet. Hunt teaches a case 26 which is attached inwardly of the first end of a sheet 12, with the openable end facing the top edge. It would have been obvious in view of Hunt to one of ordinary skill in the art at the time the invention was made to make the case of Wade attach inwardly of the first end of the sheet for the purpose of allowing it to better function as a pillow, should it be used in that manner. It would have been obvious to rotate the case of Wade 90 degrees and around the edge of the sheet, so that it faced a longitudinal edge of the sheet, for the purpose of allowing the case to be more conveniently used as a storage bag, when someone is lying on the sheet.

Claims 16-28 are rejected under 35 U.S.C. 103(a) in the same manner as in Paper No. 8, mailed February 28, 2002.

Claims 15, 18, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt. Hunt teaches all the limitations of claim 15 except the open first end of the carrying case facing a longitudinal edge of the sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to rotate the case 26 of Hunt 90 degrees so that it faced a longitudinal edge of the sheet, so that it might be more conveniently accessed when someone is lying on the sheet. The rotation of an element in such a manner is clearly within the capability of one of ordinary skill in the art. (Further, it is noted that there is no apparent criticality to the open end of the case of the Applicant's invention facing the longitudinal edge of the sheet.) Regarding claim 18, see items 22 and 24. Regarding claim 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the pockets 22 and 24 inwardly a small distance from the longitudinal edges of the sheet; this would appear to be simply a matter of design choice. Regarding claim 21, the end portion 48 will act as a carrying means attached to the case, adjacent the open end. Regarding claim 24, were the sheet of Hunt reversed and stuffed inside the case 26, the strips 50 and 52 on the flap 48 and portion 30 could secure the flap to the front wall of the case.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt as modified regarding claim 15, in view of Wade. Hunt as modified teaches all the limitations of claims 16 and 17 except a slip cover pocket at the first and second ends of the sheet. Wade teaches a slip cover pocket at the first end of the sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a slip cover pocket as taught by Wade into the invention of Hunt for

the purpose of allowing the sheet to be better restrained in wind, on any item such as a chair. Adding a slip cover pocket to the other second end is mere duplication, and would have been obvious for the same reason.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt as modified regarding claim 15, in view of Terrazas. Hunt as modified teaches all the limitations of claim 23 except a waterproof sheet attached to the bottom of the flexible sheet. Terrazas teaches a sheet with a waterproof layer for a similar purpose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to put a waterproof layer on the bottom of the sheet of Hunt in order to protect the user from moisture on a surface being rested on.

### ***Response to Arguments***

Applicant's arguments filed 26 June 2003 have been fully considered but they are not persuasive.

Contrary to the remarks at the bottom of page 8 of the appeal brief, it is not believed towel 60 of Wade is attached to the sheet 12 at 64 (using Applicant's numbering system for Wade). Applicant has no grounds to make such an assertion.

Contrary to the remarks at the top of page 9, it is believed that at least some (small) portion of the inner surface of a wall of the case 20 of Wade will be permanently attached to the sheet 12.

Contrary to the remarks at the top of page 9, regardless of the "use modes" claimed by the Applicant, it is maintained that Wade's case 20 will be reversible by pulling it inside out.

Regarding the arguments at the bottom of page 9, Applicant assumes that case 20 of Wade is attached to sheet 12 (only) by means of cloth 60. Applicant has no grounds on which to base this assertion. It is believed that sheet 12, case 20, and cloth 60 of Wade are all attached together at point 62.

Regarding the remarks at the top of page 10, it is submitted that Hunt teaches and fairly suggests modifying Wade. Hunt's invention is an analogous flexible sheet and carrying case combination. Specifically Hunt teaches a storage case 26 which is attached inwardly of a first end of a sheet 12. There is nothing to prevent turning the case 26 of Hunt inside out and storing the sheet 12 therein. It is submitted that it would have been obvious in view of Hunt to one of ordinary skill in the art at the time the invention was made to move the case 20 of Wade inwardly of the end, for any of a number of reasons, such as allowing the case 20 to better function as a pillow.

Contrary to the remarks in the middle of page 10, it is maintained that the case 20 of Wade could easily be used as a pillow, and furthermore that it would have been obvious to do so. It could be used as a pillow in the position shown, or also in the inward position, as modified by Hunt. Contrary to the remarks in boldface, were the case 20 of Wade pushed inside out, the outer surface of the carrying case would form the inner surface of the pillow case, as required by the claim.

Regarding the remarks at the top of page 12, the Silvestri reference is cited to show the obvious nature of incorporating a slip cover pocket in an end, or the ends of a sheet used for lying on.

The remaining arguments on pages 12-15 of the appeal brief only claim that the supplemental references do not address failings in the combination of Wade and Hunt. As noted above, it is submitted that the combination of Wade and Hunt addresses all of the limitations claimed, in other words, there are no "gaps." The secondary references are used simply to show the obviousness of the claimed features in the dependant claims.

Turning to the arguments at the top of page 3 of paper No. 15, how is item 26 of Hunt not a carrying case? There is nothing unobvious about turning case 26 inside out and stuffing sheet 12 inside the case for transport purposes. Contrary to the remarks, it does in fact have front and rear walls, as will be seen in Fig 2.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold  
Examiner  
Art Unit 3728

TGA  
11/6/03



Mickey Yu  
Supervisory Patent Examiner  
Group 3700